



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

1/13
1/8/04
1/18/04
J. mel

In re application of: Brent C. Parent et al.

Serial No.: 09/504,343 Group Art Unit: 3621

Filed: 02/14/2000 Examiner: HEWITT II, Calvin L.

For: SYSTEM AND METHOD FOR VIRTUAL RENTAL FLEET

Attorney Docket No.: 65678-0011

Commissioner for Patents
Mail Stop Appeal Brief - Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

DEC 18 2003

GROUP 3621

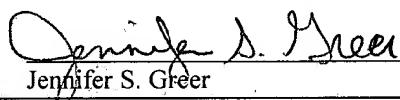
CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

deposited with the United States Postal Service
as first class mail, postage prepaid in an envelope addressed
to the Commissioner for Patents, MS Appeal Brief - Patents,
P.O. Box 1450, Alexandria, Virginia 22313-1450.

transmitted by facsimile to the
Patent and Trademark Office to
_____ at _____

Date: December 9, 2003


Jennifer S. Greer

BRIEF ON APPEAL

Honorable Sir:

This Appeal is taken from the Examiner's Final Rejection dated July 10, 2003 (hereinafter the "Final Office Action") of claims 1-21 in the above-identified application. The Notice of Appeal was timely filed on October 9, 2003. Submitted herewith are two additional copies of this Appeal Brief. Applicants (hereinafter "Appellants") respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application referenced above.

I. REAL PARTY IN INTEREST

The Real "Party-In-Interest" is Dana Corporation, located at 4500 Dorr Street, P.O. Box 10000, Toledo, Ohio 43697. Dana Corporation was assigned all rights to the

12/16/2003 MDANTE1 00000056 180013 09504343

01 FC:1402

330.00 DA

R0211233

U.S. Patent Application identified by Serial No. 09/504,343 on June 2, 2003 by Dana Commercial Credit Corporation of 660 Beaver Creek Circle, Maumee, Ohio 43537.

II. RELATED APPEALS AND INTERFERENCES

On July 9, 2003, Appellants filed a notice of appeal, and on September 9, 2003 Appellants filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/441,289 filed November 16, 1999. The application at issue in this appeal is a C-I-P application claiming priority from application 09/441,289.

On July 9, 2003, Appellants filed a notice of appeal, and on September 9, 2003 Appellants filed an Appeal Brief, appealing the final rejection of U.S. Application Serial No. 09/504,000, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289.

On October 24, 2003, Appellants filed a notice to appeal the final rejection of U.S. Application Serial Number 09/503,671, filed February 14, 2000 as a C-I-P application claiming priority from application 09/441,289. On November 25, 2003, after appellants had filed the afore-mentioned notice of appeal, the Office mailed a new final rejection of all claims. As of December 9, 2003, Appellants have not yet made a decision as to how to respond to the final rejection mailed November 25, 2003 with respect to Serial Number 09/563,671.

III. STATUS OF CLAIMS

Claims 1-21 are pending in the application and claims 1-21 are the subject of this Appeal. The present application was filed on February 14, 2000 with originally-filed claims 1-21. In response to the Office Action dated March 26, 2003, Appellants submitted an Amendment and Response to Office Action dated June 26, 2003 (hereinafter the “June 26 Response”), in which claim 1 was amended for the sole purpose of correcting a typographical error. In response to the Final Rejection dated July 10, 2003, Appellants submitted a Notice of Appeal dated October 9, 2003 and a Request for Reconsideration Pursuant to 37 C.F.R. § 1.116 dated October 9, 2003 (hereinafter the

“Request for Reconsideration”). Appellants have received no response to the Request for Reconsideration. No claims have been allowed.

Claims 1-7 and 10-21 stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,014,644 (“Erickson”) in view of U.S. Patent No. 5,744,873 (“Berent”); and claims 8-9 were rejected under 35 U.S.C. 103(a) as being obvious over Erickson in view of Berent, and further in view of U.S. Patent No. 6,161,099 (“Harrington”).

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection. A copy of all claims on appeal is attached hereto as an Appendix.

V. SUMMARY OF THE INVENTION

By way of background, the field of industrial equipment, such as forklifts, includes business entities at several different levels, including manufacturers, dealers, third-party financiers, and end-user customers. In one common arrangement, the dealer maintains an inventory of a wide variety of equipment types for rental to its end-user customers (i.e., the dealer’s “rental fleet”). Some types of equipment in the dealer’s rental fleet, however, are only infrequently needed by the dealer’s end-user customers. Accordingly, such seldomly used items experience a reduced utilization rate compared to other items in the rental fleet. The dealer tolerates reduced utilization on the seldomly used items for a number of reasons, including maintaining customer satisfaction, and, hopefully, not giving the customer a reason to shop around for a new dealer who may have larger inventory of seldomly used pieces of equipment. Conventional methods of conducting business, particularly providing rental fleets, have shortcomings that prevent the full economic value of some items in the dealer’s rental fleet from being realized.

Another common business arrangement involves a third-party financing company that buys pieces of industrial equipment from the manufacturer and then leases the equipment to the end-user customer. The customer then utilizes the industrial equipment (the customer’s “fleet”) in its business. In some circumstances, the customer actively

manages the fleet of industrial equipment, attending to repair and maintenance, the acquisition of replacement equipment, and the retirement of old or unproductive equipment from the fleet. In other circumstances, however, the leasing company performs the asset management function. In either set of circumstances, fleet managers must overcome challenges including how to effectively and efficiently determine the timing, selection, and acquisition of replacement equipment, and the disposal of equipment being retired from the fleet or coming to an end of the lease term.

Previously known approaches to dealing with the foregoing challenges fall mostly into the use of manual methods. For example, determining whether to replace a poorly performing piece of equipment was typically been based on limited data relating to the equipment known by an experienced fleet manager.

One aspect of the present invention comprises an electronic system for facilitating transactions, particularly rental transactions. The electronic system provides, in effect, a "virtual" rental fleet available to a user of the system, such as a dealer. The system includes an asset configuration unit, a market database, a market search module, a bid module, and a communications interface, all described in more detail below.

Another aspect of the present invention comprises an electronic system for establishing a virtual fleet of rental assets. The system includes a fleet module, a bid definition module, a market database, a market search module, a bid module, and a communications interface, all described in more detail below.

The fleet module is responsive to input data provided by a first user for generating asset specification data, including maintenance history data. The asset configuration unit is responsive to input data provided by a first user of the system for generating a profile of an asset. The asset profile comprises asset specification data and a bid definition. The bid definition module is responsive to user input to generate the bid definition, which outlines parameters associated with a rental transaction of the asset. The market database is configured to store a plurality of asset profiles. The market search module is configured to search the market database, based on search parameters specified by a second user, and generate an identification of assets. The bid module is configured to allow the second user to select one of the assets on which to bid. The bid module is also

adapted to provide rental options to the second user, based on the bid definition for the asset. Finally, the communications interface is configured for facilitating the electronic remote access by the second user of the system.

Through the foregoing, a dealer or the like is provided access to a "virtual" rental fleet of assets, some of which are not owned or controlled by the dealer. The system allows a user, such as a dealer, to satisfy the requirements of the dealer's end-user customer without having to maintain infrequently used items in the dealer's own rental fleet (which experience low utilization rates and thus low return on investment).

In one embodiment, the market database is configured to store information comprising asset specification data associated with a plurality of assets, such as pieces of industrial equipment. The market search module is configured to search the market database, based on search parameters specified by the user in anticipation of at least one of a purchase, rental and lease transaction. The market search module is also adapted to generate an identification of assets in accordance with the specified search parameters. At least one of the identified assets has a description that includes maintenance history data of the asset. The communications interface is configured to facilitate electronic remote access of the system by the user which, in one embodiment, occurs over a global computer network such as the Internet.

The electronic system, according to this aspect of the present invention, maximizes value extraction by making detailed information concerning the asset readily available to the user. In particular, the maintenance history of the asset constitutes information that may increase the price obtained for the asset. For example, the maintenance history data is particularly important to a dealer class of users of the system who anticipate sub-renting or sub-leasing the asset for a short term, inasmuch as a common commercial practice places the responsibility of maintenance on the dealer, not the end-user customer. Availability of information such as maintenance history data electronically, and immediately, substantially minimizes or eliminates the cost associated with information acquisition.

In another aspect of the present invention, a method also allows a user, such as a dealer having its own under-utilized assets, to consign such assets for rental by third

parties, thereby allowing an increased effective utilization rate. The method, according to this aspect of the present invention, provides detailed information concerning an asset including the maintenance history data so that the user, a potential purchaser, rentee or lessee, may evaluate the asset. The method includes use of asset specification data and a bid definition, both stored in a market database, searching the market database, providing rental options to users, and receiving user bids.

VI. ISSUES PRESENTED

- A. Whether claims 1-7 and 10-21 are unpatentable under 35 U.S.C. §103(a) over Erickson in view of Berent.
- B. Whether claims 8-9 are unpatentable under 35 U.S.C. §103(a) over Erickson in view of Berent and further in view of Harrington.

VII. GROUPING OF CLAIMS

The claims do not stand or fall together. Claim 1 stands or falls alone as Claim Group A. Claims 2-3, 10-18, and 21 stand or fall together as Claim Group B. Claims 4 and 6-7 stand or fall together as Claim Group C. Claims 8-9 stand or fall together as Claim Group D. Claim 5 stands or falls alone as Claim Group E. Claims 19-20 stand or fall together as Claim Group F. Reasons for separate patentability of the above-indicated Claim Groups A, B, C, D, E, and F are presented in the Arguments section pursuant to 37 C.F.R. § 1.192(c)(5).

VIII. ARGUMENTS

Claim Groups A, B, C, D, E, and F are in condition for allowance for at least two distinct reasons. First, the Examiner has failed to establish a *prima facie* case of obviousness because he has not specifically addressed each rejected claim limitation and the prior art of record does not teach or suggest each recited claim limitation. Glaringly, the Examiner has failed to respond to all of the arguments and the requests for support that have been presented by the Appellants in the June 26 Response and the Request for Reconsideration. For example, as detailed below, the Examiner has not provided support

for the taking of Official Notice even though the Appellants have requested, in their Request for Reconsideration, that such support be provided pursuant to 37 CFR 1.104(d)(2) and MPEP 2144.04. (No response has been received to the Request for Reconsideration, which was filed two months prior to the filing date of this Appeal Brief.) Second, the Examiner has failed to establish a *prima facie* case of obviousness by failing to provide a motivation to combine the cited art. Again, the Examiner failed to respond to all of the Appellants' arguments against combination of the cited art, which arguments were presented in the June 26 Response as well as the Request for Reconsideration.

A *prima facie* case of obviousness requires, among other things, that the applied references teach or suggest all of the claim limitations. See MPEP §2143; *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981, 180 USPQ 560, 562 (CCPA 1972). Appellants respectfully submit that the examiner failed to establish a *prima facie* case of obviousness because the references cited in the Final Office Action merely generally address some of the elements included in Appellants' claims. Consequently, the references do not teach every element of the claims, and the rejections do not satisfy the standard set forth by the Federal Circuit in *In re Thrift*, Case Number 01-1445 (Fed. Cir. August 9, 2002), which prohibits the rejections of claims based on a "very general and broad conclusion" when "cited references do not support each limitation" in a claim. Moreover, as the Federal Circuit decision in *In re Sang Su Lee*, 2002 U.S. App. LEXIS 855 (Fed. Cir. January 18, 2002) makes clear, each and every element of Appellants' claims must be supported by a prior art citation in order to reject Appellants' claims.

Claim Groups A, B, C, D, E, and F are all in condition for allowance at least because (1) the Final Office Action does not adequately identify citations in the art that would render each and every claim limitation obvious, (2) Erickson and Berent do not disclose all of the claim limitations of Claim Groups A, B, C, D, and F, nor do Erickson, Berent, and Harrington disclose all the limitations of Claim Group E and (3) the combination of the cited references would not have been obvious to one of ordinary skill in the art at the time of invention because there was no motivation to combine them.

Thus, the Examiner has failed to establish a *prima facie* case of obviousness against each of the Claim Groups.

A. All Claim Groups are allowable because there is no motivation to combine Berent and Erickson.

As mentioned above, a *prima facie* case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Appellants respectfully traverse the 103(a) rejections because there is no suggestion, motivation, or objective reason to combine the cited references. Further, the cited references teach away from the combination of references relied on by the Examiner to reject the claims.

In the June 26 Response, Appellants presented a number of arguments against the Examiner's combination of Berent and Erickson. The Final Office Action fails to address those arguments. Therefore, Appellants maintain the arguments made in the June 26 Response against combination of the cited references, including that the references teach away from their combination. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

As discussed in the June 26 Response, Erickson teaches a method and system for broadcasting, tracking, and analyzing electronic communications that take place between suppliers and buyers during a reverse bidding process. Erickson's broadcasting feature

helps buyers locate potential suppliers so that the buyers can electronically request bids from the potential suppliers. The system taught by Erickson is focused on improving communications in a reverse bidding process by storing all electronic communications, made in relation to a particular bid, in a single data object, and attaching any new communications to that single data object. Erickson's system becomes useful in the context of reverse bidding processes because such processes require extra steps of communications between suppliers and buyers. These additional steps of communications are unnecessary in a traditional straightforward bidding process, such as Berent's on-line motor vehicle auction and information system. In contrast to Erickson's system, Berent's straightforward auction does not employ the additional steps of communication that are inherent in a reverse bidding process. Consequently, combination of Erickson and Berent would change a key principle of operation of Erickson's reverse bidding process by changing the type of communications in Erickson's system.

Moreover, Erickson's reverse bidding system discloses that suppliers submit bids to interested buyers. In contrast, Berent discloses a traditional auction where potential buyers submit bids to a supplier. Thus, Berent and Erickson teach opposable functionalities. For these reasons, Erickson teaches away from a combination with Berent, and it would not have been obvious to one of ordinary skill to combine the references. Because the combination of Erickson and Berent was necessary for the rejection of every pending claim in the Final Office Action, the lack of motivation to combine Erickson and Berent renders every claim allowable.

B. All Claim Groups are allowable because the cited prior art does not teach claim limitations related to a "second user" in independent claims 1, 14, and 18.

In the June 26 Response, the Appellants' argued that Erickson does not disclose a "second user to select said one of said identified assets for placement of a bid thereon" as recited in claims 1 and 14. (Claim 18 similarly recites "(E) providing rental options to the second user based on the bid definition; and (F) receiving . . . a bid from the second user for a rental transaction.") In response to this argument, the Examiner asserts that the supplier taught by Erickson "meets the limitations associated with a second user, as the

supplier searches for bid requests . . .” (Final Office Action, page 2). However, the Examiner’s analysis of Erickson used to rebut the Appellants’ arguments is misplaced. Specifically, the Examiner incorrectly combines the functions of Erickson’s buyer with the functions of Erickson’s supplier to rebut Appellants’ arguments.

Contrary to the Examiner’s assertion, Erickson does not teach that the supplier searches for bid requests. Instead, Erickson teaches that the *buyer* searches a database for suppliers and products (Erickson, Abstract; col. 3, lines 43-51; col. 16, lines 1-19; col. 18, lines 26-41). The Final Office Action (page 6) admits that Erickson includes “a buyer searching the central database and creating a list of suppliers (col. 8, lines 27-39).” The table at column 16, lines 1-19 of Erickson specifically shows that *only a buyer* browses the supplier database to assemble a supplier list. In Erickson, there is no need for the supplier to search for bid requests because the buyer submits the bid requests to the supplier.

It appears to the Appellants that the Examiner has simply tried to shift functions of Erickson’s supplier and buyer back and forth in an attempt to teach all of the claim limitations of a first user and a second user. However, the buyer and supplier in Erickson’s reverse bidding process are not analogous to participants in a normal auction such as that of the present invention. Further, even if Erickson’s buyer and supplier satisfied each and every claim limitation related to the “second user,” they could not then simultaneously satisfy the claim limitations related to the “first user” providing input data regarding an asset recited in claims 1, 14, and 18. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness by failing to recite a teaching for each and every element of the claims. Claims 1, 14, 18, and their dependents (claims 2-13, 15-17, and 19-21) are accordingly in condition for allowance.

C. The cited art fails to disclose all of the limitations of Claim Group A because it does not disclose a “bid definition defining parameters associated with one of a purchase, rental and lease transaction of said asset”.

Independent claim 1 recites, among other things, the limitation of:

an asset configuration unit responsive to input data provided by a first user for generating a profile of an asset, said profile comprising asset specification data and a bid definition defining parameters associated with one of a purchase, rental and lease transaction of said asset;

The Examiner failed to make a *prima facie* case of obviousness with respect to this claim limitation. The cited prior art lacks any citation of a bid definition defining parameters associated with one of purchase, rental and lease transaction of said asset, as required by claim 1. Moreover, the legal authority cited by the Examiner to justify rejecting this claim limitation is not only deficient, but actually supports Appellants' argument that the limitation renders claim 1 patentable.

1. Lack of a *prima facie* case of obviousness

In disagreeing with the Appellants' assertion that "it would not be obvious to modify Erickson to encompass purchases, rental and lease transactions" (Final Office Action, page 3), the Examiner concedes that Erickson does not teach a "bid definition defining parameters associated with one of a purchase...." However, the Final Office Action next asserts that because "Erickson discloses purchasers..., the prior art reads on this limitation." (Final Office Action, page 3.) Appellants initially point out that the Final Office Action fails to address the claim limitation because claim 1 recites "parameters associated with one of a purchase..." and not "parameters associated with one of a purchasers...." Further, the portion of Erickson cited by the Examiner discloses no more than that purchasers and buyers face various tasks in completing transactions. (Erickson, column 1, lines 39-40.) Neither this portion of Erickson nor any other reference of record says anything about a "bid definition defining parameters associated with one of a purchase, rental and lease transaction of said asset" (claim 1).

Moreover, in asserting that Erickson reads on the limitation of a "bid definition defining parameters associated with one of a purchase...", the Final Office Action states no motivation for one of ordinary skill in the art to have modified Erickson. Specifically, the Final Office Action cites no motivation to modify Erickson's "purchasers" to read on the claim limitation. Page three of the Final Office Action reads:

to one of ordinary skill, purchases represent just one of a plurality of transactional methods for obtaining goods and services. Others are trade, rent, time-share or leasing. Hence it would have been obvious to one of ordinary skill in the art to use parameters that [are] associated with buying, trading, rent[ing]... etc.

It appears to the Appellants that the Examiner, without explicitly so stating, here took Official Notice as to what one of ordinary skill in the art would have viewed as equivalent to, or in the same category as, a purchase. Appellants disagree that a purchase

as recited in claim 1 is equivalent to trade, rent, time-share or leasing transactions. Further, in their Request for Reconsideration filed October 9, 2003, the Appellants respectfully requested, pursuant to 37 CFR 1.104(d)(2) and MPEP § 2144.04, a supporting affidavit or an appropriate reference in the context of the claimed invention if the Examiner planned to maintain the rejection. The Examiner to date has not supplied such an affidavit or other reference.

Further, the Examiner has not met the burden of a *prima facie* case of obviousness because the Final Office Action simply fails to state a motivation for one of ordinary skill in the art to have implemented the step that the Examiner asserts would have been obvious (“to use parameters that [are] associated with buying, trading, rent... etc.”). A *prima facie* case of obviousness also requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972).

Assuming *arguendo* that Erickson does teach a purchase as recited in claim 1, the Examiner has not met the burden of making a *prima facie* case of obviousness because the Examiner has not provided a motivation for one of ordinary skill in the art to have modified Erickson as suggested in the Final Office Action. As stated in Section 2143 of the MPEP:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Examiner has not provided the required suggestion or motivation to modify the reference teachings. Nor do the cited references provide the required motivation.

Further, the Examiner did not respond to Appellants’ argument in the June 26 Response (page 13, lines 6-9) that “it would not have been obvious to one skilled in the art to modify the teachings of Erickson to include purchase, rental, and lease transaction parameters in a bid definition because such a modification to Erickson would render the Erickson *functionality unsatisfactory* for its primary intended purpose, the purpose of

tracking communications in a reverse bidding process.” Appellants maintain this argument.

2. **Support for patentability of Appellants’ claims in the legal authority cited in the Final Office Action**

The Examiner asserts in the Final Office Action (page 3) that

this data, i.e., data associated with a rental transaction, is non-functional, as the claim[14] does not define a structural relationship between the system and the description of the data. If “rental” is replaced with “trade” for example, the claimed system performs the same way.

The Examiner is apparently asserting that “non-functional” subject matter is not patentable, and for support of this proposition evidently relies on two cases cited on page 3 of the Final Office Action. Significantly, in both cases, the Federal Circuit held that the subject matter in question was to be given patentable weight, and reversed rejections made under 35 U.S.C. § 103. *In re Lowry*, 32 F.2d 1579, 1580, 32 USPQ.2d 1031 (Fed Cir. 1994); *In re Gulack*, 703 F.2d 1381, 1382, 217 USPQ 401 (Fed. Cir. 1983).

The *Gulack* case involved the issue of whether printed matter on a substrate should be given patentable weight, and the *Lowry* court made clear that such cases were irrelevant in situations in which information was to be processed by a computer rather than the human mind. *Lowry*, 32 F.3d at 1583 (quoting *In re Bernhart*, 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969)). Beyond establishing that the Federal Circuit has a liberal view of what subject matter qualifies as functional, *Lowry* has limited relevance inasmuch as the claims at issue there recited a memory containing a data structure. *Lowry*, 32 F.3d at 1581. In contrast, the instant application recites electronic systems and methods with elements and steps employing different kinds of data.

The *Lowry* court further explained that, when establishing a *prima facie* case of obviousness, “the burden of establishing the absence of a novel, nonobvious, functional relationship rests with the PTO.” *Lowry*, 32 F.3d at 1584. Here, the Examiner clearly has not met the requisite burden. The Examiner has simply asserted that “this data, i.e., data associated with a rental transaction, is non-functional” (Final Office Action, page 3), without being wholly clear as to which claim element is at issue. Whether or not the claims define “a structural relationship between the system and the description of the data” is irrelevant to an analysis of whether the recited data element has a *functional*

relationship to the recited system elements or method steps. The statement that “[i]f ‘rental’ is replaced with ‘trade’, for example, the claimed system performs the same way” (Final Office Action, page 3) does not move the Examiner closer to meeting the requisite burden because the Final Office Action fails to explain what recited claim elements are unaffected by the swap of terms that the Examiner is proposing. That is, the Examiner’s assertion that “the claimed system performs the same way” (Final Office Action, page 3) is unclear as to what “way,” i.e., system elements or method steps, the Examiner is referring.

In short, the Appellants disagree with the Examiner’s conclusions and assert that the kind of transaction provided by the bid module as recited in claim 1 is a functional element. Simply put, according to claim 1, the second user is provided with different kinds of transactions (purchase, rental, and lease) depending on the bid definition. In other words, the system presents to the user different functionality depending on the bid definition.

Accordingly, claim 1 is in condition for allowance for the reasons stated above. Claims 2-7 and 10-13 are patentable because they depend from claim 1.

D. The cited references fail to disclose all of the limitations of Claim Group B because it does not disclose “maintenance history data” as claimed by Appellants.

Claims 2 and 14 include “maintenance history data” as part of the “asset specification data.” Method claim 18 includes the steps of “generating asset specification data associated with an asset including maintenance history data” and “searching the market database based on search parameters specified by a second user and displaying to the second user at least a portion of the asset specification data that includes the maintenance history data.”

Citing *Gulack* and *Lowry*, the Examiner asserts on page 3 of the Final Office Action that “‘maintenance history data’ is also non-functional and descriptive material will not distinguish the claimed invention from the prior art in terms of patentability.” Again, the Examiner has not met the burden of a *prima facie* case of obviousness because the Examiner has not explained why “maintenance history data” is non-functional, i.e.,

why the storage, retrieval, and display of such data is not functionally different from storing, retrieving, and displaying other kinds of data.

The recitation of asset specification data including maintenance history data provides a claim element that is clearly functional. For example, with respect to claim 2, the recited system would have a different function if a kind of data other than maintenance history data were recited. If the asset specification data included only some other kind of data (asset color, for example) or explicitly did not include maintenance history, the system would have a different utility and thus would present a different functionality.

The Examiner acknowledges on page 7 of the Final Office Action that Erickson does not teach maintenance history, but asserts that this element would have been obvious to one of ordinary skill in the art because Berent allegedly teaches “a motor vehicle auction that displays certain information about a vehicle.” Appellants’ argued in the June 26 Response (page 11) that the list of information taught by Berent does not include maintenance history data, but the Examiner failed to respond to the Appellants’ argument. Instead, without explicitly so stating, the Examiner has apparently taken Official Notice that “maintenance history data comprises descriptive information, VIN [vehicle identification number], condition and grade information” (Final Office Action, page 3). Appellants disagree, taking the position that it is inconsistent and untenable to characterize information pertaining to the present state of a vehicle as historical data. Further, as noted above, the MPEP and prevailing case law require a prior art reference such as an affidavit for each and every rejected claim element. Accordingly, in their Request for Reconsideration filed October 9, 2003, the Appellants respectfully requested, pursuant to 37 CFR 1.104(d)(2) and MPEP § 2144.04, a supporting affidavit or an appropriate reference in the context of the claimed invention if the Examiner plans to maintain the rejection. No such affidavit or reference has been supplied.

Accordingly, claims 2, 14, and 18 are in condition for allowance. Claims 3-7, 10-13, 15-17, and 19-21 are in condition for allowance as claims dependent from claims 2, 14, and 18.

E. The cited prior art does not disclose all of the limitations of Claim Group C because it does not disclose “Classes of users”.

Claim 4 recites “a bidder classification parameter defining classes of users allowed to place a bid on said asset.” The Examiner asserts on pages 3-4 of the Final Office Action that classes of users would have been obvious from Erickson because Erickson teaches “organizing data by classes” and that from this teaching, “it would have been obvious to one of ordinary skill to “organize data, using classification, whenever appropriate … where the name of the class is merely a matter of design choice.” Appellants respectfully point out that claim 4 does not recite *naming* a particular class of data, but instead recites “*defining* classes of *users*.” Thus, the Examiner’s assertion that “the name of the class is merely a matter of design choice” is irrelevant to claim 4. Appellants respectfully assert that “defining classes of *users*” would not have been made obvious by a teaching of organizing data by classes.

On page 4 of the Final Office Action, the Examiner also asserts that Erickson’s teaching of “a buyer assembling a subset of suppliers…(column 8, lines 28-38)” teaches “a bidder classification parameter defining classes of users allowed to place a bid” (claim 4). Appellants respectfully assert that “assembling a subset of suppliers” as taught by Erickson in no way equates to “defining classes of users” as claimed. The portion of Erickson cited by the Examiner teaches no more than a buyer assembling and using a list of suppliers of interest, but says nothing about classifying suppliers, much less users. (Erickson, col. 8, lines 28-38.)

In the June 26 Response (page 16), the Appellants argued that Berent failed to teach “defining classes of users” as claimed. Appellants respectfully point out that the Final Office Action fails to respond to that argument. Appellants maintain the argument as made on page 16 of the June 26 Response, including that Berent’s disclosure of user privileges specific to individual users does not teach “defining classes of users” (claim 4). Thus, in addition to being patentable by dependence from other patentable claims, claim 4 is also in condition for allowance for at least these reasons. Claims 5-9 depend from claim 4 and are allowable for this reason alone.

F. The cited prior art does not disclose all of the limitations of Claim Group D because it does not disclose “transaction characteristic data”.

In the Final Office Action, claims 8-9 (Claim Group D) were rejected under 35 U.S.C. 103(a) as being obvious over Erickson in view of Berent, and further in view of Harrington. However, Claim Group D is in condition for allowance because (1) Erickson, Berent, and Harrington do not disclose all of the claim limitations of Claim Group B, and (2) the combination of the cited references would not have been obvious to one of ordinary skill in the art at the time of invention because there is no motivation to combine the cited references. Thus, the Examiner has failed to establish a *prima facie* case of obviousness against Claim Group D.

1. The cited references fail to disclose all of the claim limitations of claims 8-9.

In the June 26 Response, Appellants argued that Harrington teaches an electronic sale of municipal bonds and does not disclose a rental transaction or transaction characteristic data for a rental transaction. The Examiner appears to have responded to this argument by asserting on pages 4-5 of the Final Office Action that Harrington teaches minimum price and list price and that these elements, along with periodic lease amount, “are also non-functional, descriptive data.” To the contrary, rental claim elements are integral to what is being recited in claims 8 and 9. For example, without a “minimum price that said second user must submit to define a valid bid,” the recited system would enable users to submit bids with prices below what the first user was willing to accept. Thus, the minimum price element fulfills a valuable function.

As discussed above in relation to Claim Group A, it would not have been obvious to one skilled in the art to modify Erickson to include bid definition parameters associated with a purchase, rental, or lease transaction. Likewise, it would not have been obvious to include transaction characteristic data for a rental or a lease transaction, let alone a list price for a predetermined period of time, a periodic lease amount, or a lease term. For at least these reasons, claims 8-9 are in condition for allowance.

2. There is no motivation to combine Erickson, Berent, and Harrington.

The Examiner has failed to state a *prima facie* case of obviousness with respect to claims 8 and 9 because, assuming *arguendo* that Harrington teaches limitations recited in claims 8 and 9, the Final Office Action provides no motivation to combine Erickson, Berent, and Harrington. The mere fact that Harrington allegedly teaches limitations recited in claims 8 and 9 is not sufficient motivation to have extended Erickson and Berent with those limitations.

As discussed above and as argued in the June 26 Response (page 19), there is no affirmative suggestion to combine Erickson and Berent. The Final Office Action fails to respond to the Appellants' arguments against combination of Harrington, Erickson, and Berent. Appellants maintain these arguments, including that there is no motivation to combine because Erickson's disclosure of a system for tracking communications in a reverse bidding process teaches away from Harrington's straightforward auction.

G. The cited prior art does not disclose all of the limitations of Claim Group E because it does not disclose a "dealer class" and a "member class."

The Examiner fails to establish a *prima facie* case of obviousness against the claim limitations of claim 5, which include a "dealer class" and a "member class." In the Final Office Action, the Examiner reasserts the argument, discussed above in relation to claim 4, regarding the purported non-functionality of Appellants' claim limitations (pages 3-4). Here, the Examiner asserts that "dealer class" and "member class" are non-functional limitations. For the same reasons discussed above, Erickson fails to teach a "dealer class" and a "member class." Again, the Examiner's assertion that "the name of the class is merely a matter of design choice" is irrelevant to claim 5. Thus, claim 5 is in condition for allowance for reasons additional to its dependence from other patentable claims.

H. The cited prior art does not disclose all of the limitations of Claim Group F because it does not disclose “registering” users as “dealers.”

As Appellants argued in the June 26 Response, the cited references do not disclose “registering” users as “dealers” as recited in claims 19-20. The Examiner asserts on page 4 of the Final Office Action that “Erickson teaches user registration”, but the portion of Erickson cited by the Examiner (col. 7, lines 46-58) simply teaches suppliers submitting profile information to a database, not “submitting registration information by supplier class” as asserted by the Examiner on page 4 of the Final Office Action. Significantly, the portion of Erickson cited by the Examiner does not even teach a registration. Moreover, inasmuch as Erickson does not teach a dealer class, as discussed above, Erickson cannot teach registering users as dealers. Therefore, claims 19-20 are in condition for allowance.

V. CONCLUSION

Appellants respectfully submit that all of the appealed claims in this application (claims 1-21) are patentable for at least the reasons stated above and request that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims. Although the Examiner cited numerous references against the Appellants’ claims, those references fail to disclose several material elements of the Appellants’ claims. Only one novel and non-obvious element is required for patentability. Numerous patentable elements are discussed herein. In summary, the rejection of Appellants’ claims was not proper because the Examiner failed to: (i) disclose all of the claim elements in prior art; and (ii) provide evidence supporting the assertion that a suggestion or motivation existed in the art to combine the references as asserted by the Examiner.

This brief is submitted in triplicate. It is believed that any fees due with respect to this paper have been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

Date: December 9, 2003

Customer No. 0102091

Telephone Number (248) 594-0600

By: 

Michael B. Stewart, Reg. No. 36,018
Charles A. Bieneman, Reg. No. 51,472
Rader Fishman and Grauer PLLC
39533 Woodward Ave, Suite 140
Bloomfield Hills, Michigan 48304
Attorneys for Appellant

APPENDIX OF CLAIMS ON APPEAL – CLAIMS 1-21

1. An electronic system for facilitating transactions comprising:
an asset configuration unit responsive to input data provided by a first user for generating a profile of an asset, said profile comprising asset specification data and a bid definition defining parameters associated with one of a purchase, rental and lease transaction of said asset;
a market database for storing a plurality of said asset profiles;
a market search module configured to search said market database based on search parameters specified by a second user and generate an identification of assets according to said search parameters, said market search module being configured to display to said second user a portion of said asset specification data for at least one of said identified assets;
a bid module configured to allow said second user to select said one of said identified assets for placement of a bid thereon, said bid module being further configured to provide at least one of purchase, rental and lease transaction options to said second user in accordance with said bid definition; and
a communications interface for facilitating electronic remote access of said system by said first and second user.
2. The system of claim 1 wherein said asset specification data includes maintenance history data, said market search module being further configured to display said maintenance history data for said at least one of said identified assets.
3. The system of claim 2 wherein said bid definition includes a bid date defining when said asset will be available for placement of a bid thereon, and an availability date defining when said asset is expected to become available for delivery.
4. The system of claim 2 wherein said bid definition includes a bidder classification parameter defining classes of users allowed to place a bid on said asset.

5. The system of claim 4 wherein said user classes include a dealer class and a member class.

6. The system of claim 4 wherein said bid definition further includes an identification of which of said purchase, rental and lease transactions are available to each class of users.

7. The system of claim 6 wherein said bid definition further includes, for each transaction identified as being available for each class of users, respective transaction characteristic data.

8. The system of claim 7 wherein said transaction characteristic data for a rental transaction comprises a list price for a predetermined period of time, and a minimum price that said second user must submit to define a valid bid.

9. The system of claim 7 wherein said transaction characteristic data for a lease transaction comprises a periodic lease amount and a lease term.

10. The system of claim 2 wherein asset configuration unit comprises a fleet module configured to generate and store said asset specification data in a fleet database, said configuration unit further including a bid definition module configured to generate and associate said bid definition with said asset specification data to define said asset profile, said bid definition module being further configured to store said asset profile in said market database.

11. The system of claim 2 wherein said bid module is further configured to generate a bid history for said first user including a detail of each bid submitted by said second user.

12. The system of claim 2 wherein said bid is a first bid, said bid module being further configured to allow a third user to select said asset for placement of a second bid thereon, said bid module being further configured to provide purchase, rental and lease transaction options for selection by said third user in accordance with said bid definition, said bid module being further configured to generate a bid history for said first user including a detail of each bid submitted for said asset by said second and third users of said system.

13. The system of claim 12 wherein said bid module is further configured to allow said first user to choose one of said bids from said bid history, and to complete said transaction offered by said chosen bid.

14. An electronic system for establishing a virtual rental fleet of assets comprising:

a fleet module responsive to input data provided by a first user for generating asset specification data associated with an asset, including maintenance history data;

a bid definition module responsive to further input data provided by said first user configured to generate a bid definition defining parameters associated with a rental transaction contemplated for said asset, said bid definition module being further configured to associate said bid definition with said asset specification data to thereby define an asset profile that is stored in a market database;

a market search module configured to search said market database based on search parameters specified by a second user, said market search module being further configured to generate an identification of assets according to said search parameters, and display to said second user at least a portion of a said asset specification data including said maintenance history data for one of said identified assets;

a bid module configured to allow said second user to select one of said identified assets for placement of a bid thereon, said bid module being further configured to provide rental transaction options to said second user in accordance with said bid definition, said

bid module being further configured to generate a bid history for said first user including a detail of said bid; and

 a communications interface for facilitating electronic remote access of said system by said second user.

15. The system of claim 14 wherein said bid module is further configured to allow said first user to complete the rental transaction contemplated by said bid.

16. The system of claim 15 wherein said second user is a first dealer registered with said system.

17. The system of claim 16 wherein said first user is a second dealer registered with the system.

18. A method of consigning an asset on an electronic market for rental, comprising the steps of:

- (A) generating asset specification data associated with an asset including maintenance history data using input data from a first user of the electronic market;
- (B) generating a bid definition defining parameters associated with a rental transaction of the asset using further input data from the first user;
- (C) storing the asset specification data and the bid definition together in an asset profile in a market database;
- (D) searching the market database based on search parameters specified by a second user and displaying to the second user at least a portion of the asset specification data that includes the maintenance history data;
- (E) providing rental options to the second user based on the bid definition; and
- (F) receiving, through a global computer network, a bid from the second user for a rental transaction.

19. The method of claim 18 further comprising the step of: registering the second user as a dealer.

20. The method of claim 19 further comprising the step of: registering the first user as a dealer.

21. The method of claim 20 further comprising the steps of: receiving an acceptance of the bid from the first user; and closing the transaction specified by the bid.



AP/3621
#

TRANSMITTAL OF APPEAL BRIEF

Docket No.
65678-0011

In re Application of: Andrew F. Suhy, et al.

Application No. 09/504,343-Conf. #7770	Filing Date February 14, 2000	Examiner Hewitt II, Calvin L.	Group Art Unit 3621
-------------------------------------------	----------------------------------	----------------------------------	------------------------

Invention: SYSTEM AND METHOD FOR VIRTUAL RENTAL FLEET

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: October 9, 2003.

The fee for filing this Appeal Brief is 330.00.

Large Entity Small Entity

A check in the amount of _____ is enclosed.

Charge the amount of the fee to Deposit Account No. 18-0013
This sheet is submitted in duplicate.

Payment by credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any additional fees that may be required or
credit any overpayment to Deposit Account No. 18-0013
This sheet is submitted in duplicate.

RECEIVED

DEC 18 2003

GROUP 3600

Dated: December 9, 2003

Charles A. Bieneman

Attorney Reg. No. : 51,472

RADER, FISHMAN & GRAUER PLLC
39533 Woodward Avenue

Suite 140

Bloomfield Hills, Michigan 48304
(248) 594-0648

Appeal Brief Transmittal

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: December 9, 2003

Signature: Jennifer S. Greer (Jennifer S. Greer)